



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,095	08/17/2000	Donald B. Benson	40016420-0001	5295

26565 7590 10/07/2003

MAYER, BROWN, ROWE & MAW  
P.O. BOX 2828  
CHICAGO, IL 60690

EXAMINER
----------

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,095

Applicant(s)

BENSON, DONALD B.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

- 1) The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

- 2) Claims 19-23 are objected to because of the following informailities:

In Claim 19, line 9, --and-- should be inserted after “.”.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered second claim 8 should be renumbered 9. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

- 3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4) Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, lines 9 and 17; and Claim 26, line 5, respectively, the term "unique" is a subjective, relative term which renders the claim indefinite. The term "unique" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In Claim 1, lines 3 and 19; and Claim 19, lines 2 and 14, respectively, the term "optimized" is a subjective, relative term which renders the claim indefinite. The term "optimized" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 24, 25, 26 and 27 suffer the identical indefiniteness as cited above.

In Claim 24, it is not clear whether the claim is directed to a method claim or apparatus claim. To be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961). The structural limitation is of no patentable moment unless it affects the process in a manipulative sense. Ex parte Kangas, 125 USPQ 419 (PTO Bd. App. 1960).

***Claim Rejections - 35 USC § 102***

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6) Claims 1-8, 10-12, 14-17, 19-20 and 24-27, as far as they are definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US 5,287,976).

**W.R.T. Claim 1:**

Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications

Art Unit: 3629

with each of the plurality of recipients (see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and

a co-mailer for combining the plurality of first publications with the plurality of second publications to form the plurality of diverse publications, the co-mailer merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (*Id.*).

**W.R.T. Claims 2-8, 10-12, 14-17:**

Mayer et al. further discloses the system comprising:

wherein the order is a demographical-based order (col. 1, line 12 – col. 5, line 53);

wherein the bindery binds the plurality of first publications and a second bindery binds the plurality of second publications (see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

wherein the plurality of diverse publications comprises magazines, catalogs, books...;

wherein the order is maintained in a verified sequence list, the list being transferred from the bindery to the co-mailer (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

a bindery bundling device for stacking and wrapping (50) the plurality of publications in the order (see Fig. 5 and the description thereof);

a sortation device coupled and in communication with the co-mailer (*Id.*);

Art Unit: 3629

a bundling device for stacking and wrapping the plurality of diverse publications, being in communication with the co-mailer (*Id.*);

a co-mailer verification device, the device verifying the order of each of the diverse publications using an identifier information (col. 6, lines 35-61);

a bindery verification device, verifying the order of each of the plurality of publications (*Id.*);

wherein the order is contained in a verified sequence list, the list created by a bindery sequence list module in communication with a bindery control module, the control module transmitting the verified sequence list to the bindery for performing a first print of an identifier information (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

wherein the co-mailer further comprises:

a co-mailer merger and sequence module for receiving a plurality of verified sequence lists from the bindery, each of the verified sequence lists containing the order for each of publications received from the bindery, the co-mailer merge and sequence module merging each of verified sequence lists to create a merged verified sequence list, the merged sequence list sequenced in the order to determine the mail rate (*Id.*);

a co-mailer control module, the control module receiving the merged verified sequence list from the co-mailer merge and sequence module, the co-mailer control module transmitting the merged verified sequence list to the co-

Art Unit: 3629

mailer (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

wherein the co-mailer further comprises:

a co-mailer control module for verifying on a merge stream on the co-mailer; and

wherein the co-mailer further comprises:

a co-mailer control module, the control module driving a sortation device, the sortation device sorting each of diverse publications by the mail rate, the control module driving a bundling of the diverse publications leaving the sortation device (*Id.*).

**W.R.T. Claims 19 and 24:**

Mayer et al. discloses a method comprising:

providing a unique order to a binder, the unique order defining an order that each of a plurality of publications are bound by the bindery (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

binding, by the bindery, a plurality of signatures to create the publications, each of the plurality of publications being in the unique order (*Id.*); and

co-mailing a plurality of diverse publications by merging the publications in the unique order to form the diverse publications and sending the diverse publications to the recipients (*Id.*).

**W.R.T. Claim 20:**

Mayer et al. further discloses the method comprising:



Art Unit: 3629

providing the order in a form of a record list to a bindery sequence list module in communication with bindery, the record list containing an identifier information for each of recipients (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and

sequencing the record list in a predetermined sequence to obtain a sequence list.

**W.R.T. Claim 25:**

Mayer et al. discloses a system comprising:

a co-mailer for combining the plurality of diverse publications, the co-mailer merging the plurality of diverse publications (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and

a sortation device coupled and in communication with the co-mailer, the sortation device sorting each of the plurality of diverse publications from the co-mailer.

**W.R.T. Claim 26:**

Mayer et al. discloses a method comprising:

co-mailing the plurality of diverse publications by merging the plurality of diverse publications in an order (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims); and

sorting each of the plurality of diverse publications from the co-mailer to deliver each of the diverse publications to the plurality of recipients.

**W.R.T. Claim 27:**

Mayer et al. discloses a method comprising:

binding, by a bindery, a plurality of signatures to create a plurality of first publications and second publications (col. 1, line 12 – col. 5, line 53; see Figs. 1, 4-6 and the description thereof; abstracts; and Claims);

bindery printing, at the bindery, an identifier information on each of the publications to identify each of the recipients; and

co-mailing the diverse publications by:

merging the first publications with the second publications; and

co-mailer printing the mail rate at the co-mailer on each of the diverse publications.

7) Claims 1-5, 7, 9-12, 14-20 and 24-28, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Ramsey (US 6,445,975).

**W.R.T. Claim 1:**

Ramsey discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof); and

a co-mailer for combining the plurality of first publications with the plurality of second publications to form the plurality of diverse publications, the co-mailer merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (*Id.*).

**W.R.T. Claims 2-5, 7, 9-12, 14-18:**

Ramsey further discloses the system comprising:

wherein the order is a demographical-based order (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

wherein the bindery binds the plurality of first publications and a second bindery binds the plurality of second publications (*Id.*);

wherein the plurality of diverse publications comprises magazines, catalogs, books...;

wherein the order is maintained in a verified sequence list, the list being transferred from the bindery to the co-mailer (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

a sortation device coupled and in communication with the co-mailer;

a first print head, the head printing a mail rate on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications (*Id.*); and

a second print head, the second head printing the mail rate on a second predetermined number of each of the diverse publications in a customized orientation

Art Unit: 3629

and a customized placement on a second portion of each of the plurality of diverse publications (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

a co-mailer verification device, the device verifying the order of each of the diverse publications using an identifier information (*Id.*);

a bindery verification device, verifying the order of each of the plurality of publications (*Id.*);

wherein the order is contained in a verified sequence list, the list created by a bindery sequence list module in communication with a bindery control module, the control module transmitting the verified sequence list to the bindery for performing a first print of an identifier information (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

wherein the co-mailer further comprises:

a co-mailer merger and sequence module for receiving a plurality of verified sequence lists from the bindery, each of the verified sequence lists containing the order for each of publications received from the bindery, the co-mailer merge and sequence module merging each of verified sequence lists to create a merged verified sequence list, the merged sequence list sequenced in the order to determine the mail rate (*Id.*);

a co-mailer control module, the control module receiving the merged verified sequence list from the co-mailer merge and sequence module, the co-mailer control module transmitting the merged verified sequence list to the co-mailer (*Id.*);

Art Unit: 3629

wherein the co-mailer further comprises (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof):

a co-mailer control module for verifying on a merge stream on the co-mailer;

wherein the co-mailer further comprises (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof):

a co-mailer control module, the control module driving a sortation device, the sortation device sorting each of diverse publications by the mail rate, the control module driving a bundling of the diverse publications leaving the sortation device;

wherein the co-mailer further comprises (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof): and

a co-mailer control module, the co-mailer control module controlling a first print head and a second print head on the co-mailer, each of the first and second print heads printing an identifier information on each of diverse publications in a customized orientation and a customized placement on a portion of each of diverse publications.

**W.R.T. Claims 19 and 24:**

Ramsey discloses a method comprising:

providing a unique order to a binder, the unique order defining an order that each of a plurality of publications are bound by the bindery (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

binding, by the bindery, a plurality of signatures to create the publications, each of the plurality of publications being in the unique order (*Id.*); and

co-mailing a plurality of diverse publications by merging the publications in the unique order to form the diverse publications and sending the diverse publications to the recipients.

**W.R.T. Claim 20:**

Ramsey further discloses the method comprising:

providing the order in a form of a record list to a bindery sequence list module in communication with bindery, the record list containing an identifier information for each of recipients (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof); and

sequencing the record list in a predetermined sequence to obtain a sequence list (*Id.*).

**W.R.T. Claim 25:**

Ramsey discloses a system comprising:

a co-mailer for combining the plurality of diverse publications, the co-mailer merging the plurality of diverse publications (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof); and

a sortation device coupled and in communication with the co-mailer, the sortation device sorting each of the plurality of diverse publications from the co-mailer.

**W.R.T. Claim 26:**

Art Unit: 3629

Ramsey discloses a method comprising (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof):

co-mailing the plurality of diverse publications by merging the plurality of diverse publications in an order; and

sorting each of the plurality of diverse publications from the co-mailer to deliver each of the diverse publications to the plurality of recipients.

**W.R.T. Claim 27:**

Ramsey discloses a method comprising:

binding, by a bindery, a plurality of signatures to create a plurality of first publications and second publications (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

bindery printing, at the bindery, an identifier information on each of the publications to identify each of the recipients (*Id.*); and

co-mailing the diverse publications by:

merging the first publications with the second publications; and

co-mailer printing the mail rate at the co-mailer on each of the diverse publications.

**W.R.T. Claim 28:**

Ramsey discloses a co-mailer comprising:

a plurality of pockets for receiving the plurality of diverse publications (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

a merge stream for receiving the diverse publications;

a first print head in the merge stream, the first head printing a mail rate on a predetermined number of each of the diverse publications in a customized orientation and a customized placement on a first portion of the predetermined number of the diverse publications (*Id.*); and

a second print head in the merge stream, the second head printing the mail rate on a second predetermined number of each of the diverse publications in a customized orientation and a customized placement on a second portion of the predetermined number of the diverse publications.

### ***Claim Rejections - 35 USC § 103***

8) Claims 13 and 21, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsey in view of Graushar (US 5,025,610).

#### **W.R.T. Claims 13 and 21:**

Ramsey discloses the invention as recited earlier and further discloses the binding step further comprising:

selecting the plurality of signatures based on at least one field in the record list for each of the recipients (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof);

binding the plurality of signatures selected in the selecting step;



Art Unit: 3629

printing an identifier information from the sequence list on the plurality of signatures; and

verifying the unique order of the publications, the verifying step further comprising updating the sequence list to record each of the publications that are not in the unique order to generate a verified sequence list (see Figs. 1-2, 13, 17-25, 40-47 and the descriptions thereof).

However, Ramsey does not specifically disclose the invention including:

determining a weight and a thickness of each of publications, the weight and the thickness being inserted into the sequence list by using a thickness device and a weight device.

Graushar teaches, for an apparatus and method for selectively packaging magazines, that the system comprises a thickness and weight devices (col. 3, line 68 – col. 4, line 15; col. 4, line 45 – col. 5, line 17).

Since Graushar and Ramsey are both from the same field of endeavor, the purpose disclosed by Graushar would have been well recognized in the pertinent field of Ramsey.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize the thickness and weight devices, as

taught by Graushar, for the purpose of determining a weight and a thickness of each of publications to qualify for the best available postal rate under carrier route sortation.

***Allowable Subject Matter***

9) Claims 22-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4,790,119 is cited to show an apparatus and process for organizing publications for distribution in a postal system. The system arranges the publications in stacks which comply with the requirements for carrier route sortation.

US 6,098,057 is cited to show a method and apparatus for processing mail pieces by a mailer for mailing by a postal facility utilizing a manifesting system to evidence payment by the mailer to the postal facility for the cost of the mailing.

US 4,576,370 is cited to show a method and apparatus for automatically tipping closely incidental mail to publications. A plurality of publications are sequentially fed from a source location to a sort stacking location. A labeling station and an envelope tipping station are disposed intermediate the source and town sort location.

US 5,419,541 is cited to show a method for selectively binding pre-personalized inserts into book type publications, including the steps of providing batches of pre-personalized inserts and other inserts, providing a binding line equipped with a selective binding control system, providing a sequential feed for pre-personalized inserts to the binding line along with a diverter and introducer for other inserts into specific books.

US 5,143,362 is cited to show a method and apparatus providing the personalization of publications. The method comprises the steps of automatically: printing at least one personalized signature; assembling the personalized signature with at least one other signature; detecting the detectable personalized printing on the personalized signature; and printing address information on the cover.

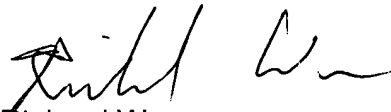
US 6,269,609 is cited to show an apparatus and method to produce publications in a single stream of products towards a packaging line, divide the single stream of products into distinct streams of products where one such stream comprises products requiring wrapping and another such stream comprises products without wrapping.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

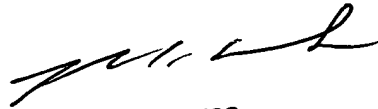
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-308-3691 for After Final communications.

Art Unit: 3629

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
Patent Examiner  
GAU 3629  
September 29, 20003



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600